

REMARKS

Claims 1-3, 5, 6, and 9-26 are pending in the application. Claim 10 has been cancelled from the application. Therefore, claims 1-3, 5, 6, 9, and 11-26 are at issue.

Claim 1 has been amended to recite that the hydric solvent comprises dipropylene glycol, benzyl alcohol, or a mixture thereof. Support for this amendment can be found in claims 11 and 12 and in the specification, e.g., in the examples which contain dipropylene glycol or benzyl alcohol. Claims 11, 12, and 26 have been amended to delete redundancies from these claims in view of the amendment to claim 1. Claim 9 has been amended to recite that the hydric solvent comprises dipropylene glycol. Support for this amendment can be found in the Table of Example 4 at page 25 of the specification. Claim 16 has been amended to improve the form of the claim.

Claims 1-3, 5, 6, and 9-26 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or alternatively under 35 U.S.C. §103 as being obvious over, Beerse et al. U.S. Patent No. 6,294,186 ('186). The examiner contends that the '186 patent discloses the claimed compositions and methods, or renders the claimed compositions and methods obvious. In view of the amendments to the claims, and for the reasons set forth below, it is submitted that this rejection should be withdrawn.

First, the '186 patent was cited in the Office Action of July 5, 2005, and this reference was overcome in Amendment "A," filed November 7, 2005. See Office Action of January 24, 2006, page 2, in which the

examiner states that the rejection of the claims over the '186 patent was withdrawn. For the convenience of the examiner, applicants reiterate the reasons why the present claims are patentable over the '186 patent. Applicants also provide *additional* reasons why the presently amended claims are patentable over the '186 patent because of the recitation of dipropylene glycol, benzyl alcohol, or a mixture thereof as components of the hydric solvent.

The '186 patent primarily teaches an anti-microbial composition containing a benzoic acid analog and a metal salt ('186 patent abstract). Also see '186 patent, column 3, lines 32-48. The '186 patent further teaches, explicitly, that the metal salt contributes to the antimicrobial activity. For example, the '186 patent states, at column 7, lines 60-65:

"Without being limited by theory, it is believed that in the compositions of the present invention, the benzoic acid analog and metal salt complex to form a metal-acid complex which has been found to provide a synergistic immediate and residual anti-viral and antibacterial efficacy to surfaces to which such compositions are applied."

The '186 patent also contains 42 examples. Of these examples, 41 contain a metal salt as an antimicrobial agent.

The '186 patent also discloses a second embodiment wherein the composition contains a benzoic acid analog and a dermatologically effective carrier, and is essentially free of metal salts. See '186 patent, column 47, lines 18-54. The '186 patent contains one example (Example 21) that is free of a metal

salt. The composition of this example also contains a total of 10 wt% of surfactants. The definition of dermatologically effective carriers in the '186 patent includes surfactants of the type disclosed in Example 21. See '186 patent, column 8, line 49 through column 9, line 3.

In contrast to the teachings of the '186 patent, the present claims recite a composition wherein an aromatic carboxylic acid is the *sole* antimicrobial agent in the composition and the composition contains 0% to about 0.2%, by weight, of a surfactant, i.e., is essentially free of a surfactant. The '186 patent explicitly teaches that the metal salt is an essential ingredient in one embodiment of the invention. In contrast to the '186 patent, the present claims exclude the presence of a metal salt that is taught as essential in the '186 patent.

In the second embodiment disclosed in the '186 patent, a metal salt is absent from a composition containing a benzoic acid analog and a dermatologically acceptable carrier. A major carrier exemplified in the '186 patent in connection with this embodiment is a high (10 wt%) amount of surfactant (see '186 patent, Example 21). In contrast, the present claims recite a composition that contains 0% to about 0.2%, by weight, of a composition. Example 21 of the '186 patent also is free of a hydric solvent, which is a presently claimed ingredient in an amount of about 5% to about 50%, by weight, of the composition.

The '186 patent also discloses that the carrier can be an alcohol solution, i.e., monohydric and/or dihydric alcohols. The preferred alcohols are

monohydric C2-C18 alcohols, and the only specifically named alcohols are ethanol, isopropanol, n-propanol, butanol, and mixtures thereof. In contrast, the present claims recite dipropylene glycol, benzyl alcohol, or mixtures thereof as components of the hydric solvent.

It is submitted that the present claims cannot be anticipated by the '186 patent because a difference exists between the '186 patent disclosure and the present claims. The '186 patent fails to teach (a) a composition that contains only an aromatic carboxylic acid as the antimicrobial agent and (b) that contains 0% to 0.2%, by weight, of a surfactant and (c) that contains about 5% to about 50%, by weight, of a hydric solvent comprising dipropylene glycol, benzyl alcohol, or a mixture thereof. Therefore, the rejection of the present claims as being anticipated by the '186 patent under 35 U.S.C. §102(b) should be withdrawn.

It is further submitted that the differences between present claims and the '186 patent would not have been obvious to a person skilled in the art under 35 U.S.C. §103. The '186 patent stresses the necessity of including a metal salt in the composition in order to achieve an enhanced antimicrobial action. The '186 patent also includes 42 examples, of which 41 contain a metal salt as an antimicrobial component. The sole example in the '186 patent omitting a metal salt, i.e., Example 21, contains a high percentage of anionic surfactant and is lacking a hydric solvent. The '186 patent fails to teach or suggest a composition that omits a metal salt, and is essentially free of a sur-

factant, and includes a hydric solvent, as presently claimed. From the teachings of the '186 patent, a person skilled in the art would not have been motivated to omit a metal salt and omit a surfactant and include a claimed hydric solvent with any reasonable expectation of providing a useful antimicrobial composition.

In addition, the presently claimed invention exhibits unexpected results, even when the essential metal salt of the '186 patent is omitted. In particular, the present examples show an unexpectedly high antimicrobial efficacy when both an aromatic carboxylic acid and a claimed hydric solvent are present (see Examples 1, 4, 7, and 9). Comparative Examples 2 and 3 show that both the aromatic carboxylic acid and hydric solvent are needed to achieve a high antimicrobial efficacy.

These results are unexpected over the disclosure of the '186 patent, which specifically discloses that the metal salt is essential to the '186 invention and which fails to teach or suggest including a presently claimed hydric solvent in the disclosed composition. The teachings of the '186 patent with respect to alcohols as carriers would not motivate a person skilled in the art to eliminate the metal salt, and substitute dipropylene glycol and/or benzyl alcohol therefor, with any reasonable expectation of providing the antimicrobial efficacy demonstrated by the presently claimed compositions.

In summary, persons skilled in the art simply would not be motivated make the several jumps in reasoning needed to arrive at the presently claimed invention after reading the '186 patent. Therefore, in view

of the substantial differences between the '186 patent and the present claims, it is submitted that the rejection of the pending claims as being obvious over the '186 patent under 35 U.S.C. §103 should be withdrawn.

Claims 1-3, 5, 6, and 9-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by Seitz U.S. Patent No. 6,861,397 ('397), or, alternatively, under 35 U.S.C. §103 as being obvious over the '397 patent. It is submitted that this rejection is in error and should be withdrawn.

First, the '397 patent was cited in an obviousness-type double patenting rejection in the Office Action of January 24, 2006. Applicants timely filed a terminal disclaimer on April 21, 2006 to overcome this obviousness-type double patenting rejection. The examiner failed to note the filing of this terminal disclaimer in the present Office Action.

Furthermore, it is submitted that the '397 patent is not available as a reference against the present application. The '397 patent is assigned to The Dial Corporation, Scottsdale, AZ (Recorded at Reel Number 13290, Frame 0947, on September 17, 2002). The present application also is assigned to The Dial Corporation (Recorded at Reel Number 15159, Frame 0142, April 11, 2004). In particular, the present application and the '397 patent, at the time the invention of the present invention of the present application was made, were owned by, or subject to an obligation of the assignment to, The Dial Corporation. See M.P.E.P. §706.02(1)(1)-(3). In summary, the '397 patent is disqualified as prior art, and the rejection should be withdrawn.

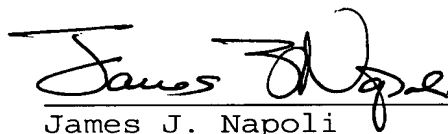
It is submitted that the claims are of proper form and scope for allowance. An early and favorable action on the merits is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

By

A handwritten signature in dark ink, appearing to read "James J. Napoli", is written over a horizontal line.

James J. Napoli
(Registration No. 32,361)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 474-6300

Chicago, Illinois
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